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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,973	02/18/2004	Ilya Ostrowsky	DNAG-278 (10402028)	1039
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FULBRIGHT & JAWORSKI, LLP				
666 FIFTH AVE				
NEW YORK, NY 10103-3198				
EXAMINER				
LEADER, WILLIAM T				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
10/07/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/781,973

Applicant(s)

OSTROVSKY, ILYA

Examiner

WILLIAM T. LEADER

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 63-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 63-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 7/3/2008.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Receipt of the papers filed on June 27, 2008 and the Information Disclosure Statement filed on July 3, 2008, is acknowledged. Claims 63-74 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 63-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan (6,916,414) in view of Schaedel (4,152,221) or Honda et al (6,690,573) or Covino (4,861,440), newly cited, and further in view of the Lowenheim text *Electroplating* for the reasons of record.

Double Patenting

4. Claims 63-74 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 6,875,334 in view of Kinase et al (4,416,742) for the reasons of record.

Response to Arguments

5. Applicant's arguments filed June 27, 2008 have been fully considered but they are not persuasive. Applicant has amended independent claim 63 to recite passing an electric current "to form a gel layer on said metallic substrate." At page 4 of the Remarks, applicant argues that Dolan does not discuss gel formation. While this may be correct, the newly added limitation is not considered to distinguish applicant's claimed process from that suggested by Dolan and the other applied references. At paragraph [0059] of applicant's specification it is stated that "any anodizing process may have a stage of gel formation." In paragraph [0062] it is stated that "During the anodizing, plasma arcs and a gel micelles containing gel layer are generated. The gel micelles are present when current is applied and when there is an electrical field." The operative process steps suggested by the applied references are the same as those utilized by applicant for treating a metal surface. With the treatment solution of Dolan, the generation of a sustained plasma (visible light emitting discharge) during anodization may be attained using a pulsed DC voltage in some instances of no more than 80 volts. See column 5, lines 28-35. Since a plasma is formed by Dolan, a gel would have been expected to have formed in the same way a gel forms when plasma arcs are formed during the anodizing process of applicant. Applicant has offered no explanation as to why a gel is formed

in the claimed process but would not have been formed in the process suggested by Dolan and the other applied references.

6. With respect to the double patenting rejection, applicant states that NH_2OH is not an alcohol. This is considered to be correct. However, the double patenting rejection is not based on the claims of patent 6,875,334 alone, but the '334 claims in view of Kinase et al. Claim 1 of the '334 patent recites a solution which contains hydroxylamine. Kinase et al discloses that both triethanolamine and the hydroxylamine recited in claim 1 of the patent are recognized additives for use in coating baths. Thus, it would have been obvious to have utilized triethanolamine in place of the hydroxylamine recited in the claims of the '334 patent because Kinase et al shows them to be equivalent additives.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM T. LEADER whose telephone number is (571) 272-1245. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Susy Tsang-Foster can be reached on 571-272-1293. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Leader/
September 25, 2008

/SUSY N TSANG-FOSTER/
Supervisory Patent Examiner, Art Unit 1795